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UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY M. ENRIGHT

Appeal No. 2003-0990
Application No. 09/439,718

ON BRIEF

Before KRASS, RUGGIERO and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-43.

The invention is directed to a cash dispensing method for a self-service facility such as a motor fuel dispensing facility.

Representative independent claim 38 is reproduced as follows:

38. A method comprising the steps of:

- a) paying for a first charge for merchandise delivered to a user at a first self-service dispensing machine, including accepting an amount of cash with a cash accepting device;
- b) generating a code, wherein the code corresponds to an amount of change, wherein the amount of change corresponds to the difference between the first charge and the amount of cash;
- c) outputting the code to the user; and
- d) paying for a second charge for merchandise delivered to the user at a second self service dispensing machine, including inputting the code and reducing the second charge by the amount of change that corresponds to the code.

The examiner relies on the following references:

Gatto	5,859,416	Jan. 12, 1999 (filed May 1, 1996)
Phillips et al. (Phillips)	6,193,154	Feb. 27, 2001 (filed Aug. 24, 1994)

Claims 38 and 39 stand rejected under 35 U.S.C. § 102(e) as anticipated by Phillips.

Claims 1-37 and 40-43 stand rejected under 35 U.S.C. § 103 as unpatentable over Phillips in view of Gatto.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

An anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person

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of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that instant claims 38 and 39 are anticipated by Phillips because Phillips discloses, at column 27, lines 22-39, the acceptance of an amount of cash for merchandise and, at column 3, lines 13-22, the generation of a code for the amount of change, as well as the output of a code on a receipt and the payment of a second charge by inputting the code, at column 3, lines 41-42. With regard to claim 39, the examiner alleges that Phillips' receipt reads on indicia representative of the code.

Appellant argues that Phillips does not teach "generating a code" which corresponds to a difference between a merchandise charge and an amount of cash accepted, as claimed. In fact, appellant argues, there is no indication that Phillips' fuel dispenser permits accepting cash.

We will not sustain the rejection of claims 38 and 39 under 35 U.S.C. § 102(e) because Phillips does not appear to disclose each and every limitation of claims 38 and 39.

Phillips discloses a vending machine next to a fuel dispensing station so that the vending machine is usable in conjunction with a credit card accepting self-service fuel

dispensing gasoline pump. Thus, the fuel dispensing station will accept a credit card to pay for the fuel and, if desired, to pay for a soda from the vending machine, permitting a purchase from the vending machine without cash. As disclosed at column 6, lines 42-55, of Phillips, there is an option for the vending machine to accept coins and paper money. Moreover, as disclosed at column 3, lines 13-22, of Phillips, a code is created that is usable in the vending machine so that purchases in the vending machine are enabled via the same credit card transaction as is used in the self-service fuel dispensing pump.

However, the code generated in Phillips does not correspond to an amount of change, wherein the amount of change corresponds to the difference between the first charge and the amount of cash, as required by claim 38, because there is no "change" disclosed in Phillips. There does not seem to be any provision in Phillips, at all, for accepting cash at the fuel dispensing pump. Thus, if the user pays for a first charge, i.e., for an amount of fuel, at the first self-service dispensing machine, this first dispensing machine does not include "accepting an amount of cash with a cash accepting device," as claimed. While Phillips' second self-service dispensing machine, e.g., a soda machine, may accept cash, this is not the claimed "first" self-

service dispensing machine. If we call the soda machine in Phillips the "first" machine, since this may accept cash, this machine does not generate the claimed code. While the claimed code is not specifically recited as being generated by the first dispensing machine, it is clear from the order of steps in method claim 38 that payment is first charged at the first dispensing machine, a code is generated, wherein that code corresponds to an amount of change, wherein the amount of change corresponds to the difference between the first charge and the amount of cash (thus, the code generation is related to the first charge made at the first dispensing machine) and then that code is used in paying the second charge at the second dispensing machine. Since the code is not used in Phillips to pay for the charge at the fuel dispensing machine, the instant claimed subject matter is not met if the soda vending machine in Phillips is considered the claimed "first self-service dispensing machine." Moreover, if the fuel dispensing machine in Phillips is considered as the claimed "first self-service dispensing machine," and Phillips' soda vending machine is considered to be the claimed "second self-service dispensing machine," the claimed subject matter is still not met because Phillips "first" dispensing machine does not accept an amount of cash, as claimed. Further, the code in

Phillips does not correspond to an amount of change nor is there any disclosure of an amount of change corresponding to a difference between a first charge and the amount of cash.

In fact, at pages 6-7 of the answer, the examiner admits that Phillips does not teach the claim limitation of the code corresponding to a difference between a merchandise charge and an amount of cash accepted. But, even though the examiner apparently recognizes this difference, the examiner contends that while the specific example embodiment of Phillips does not teach this limitation, this teaching of a difference between a merchandise charge and an amount of cash accepted is "inherent" through Phillips teaching of options, in that one of the dispensing machines can optionally accept cash.

The examiner's reasoning is misplaced. For something to be "inherent," it must **necessarily** occur in the prior art. Even if there may be a possibility that Phillips could be construed to suggest such a "difference," inherency cannot be established by a mere possibility. The examiner has failed to show that the claimed "difference between the first charge and the amount of cash" must, of necessity, occur in Phillips. As such, the examiner may not rely on "inherency" as a basis for an anticipation rejection.

The examiner also contends that since Phillips teaches that one of the dispensing machines may accept cash and that one of the dispensing machines can issue a receipt bearing a code that can be input to purchase from the other dispensing machine, one of ordinary skill in the art "would know that many people prefer not to use credit cards" and that, for these customers, the invention would be "advantageous if it took a ten dollar bill for the joint purchase" (answer, page 7).

The problem with this reasoning by the examiner is that it smacks of "obviousness." But, the rejection is under 35 U.S.C. § 102, not § 103. Therefore, since the rejection is based on anticipation, the examiner must show where each and every claimed element is taught in Phillips. It is not enough, under 35 U.S.C. § 102, that the skilled artisan would have, or might have, found it obvious to have the first dispensing machine that generates the code also accept cash.

We will not sustain the rejection of claims 38 and 39 under 35 U.S.C. § 102(e) because the examiner has failed to establish a prima facie case of anticipation.

Turning to claims 1-37 and 40-43, the examiner rejects these claims under 35 U.S.C. § 103 by relying on Phillips but bringing in Gatto to supply a teaching of a facility remote from the

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machine (answer, page 3), of a second good being an amount of cash (answer-page 5) and of debit and stored value cards (answer, page 5). The examiner also relies on Official notice regarding claims 25, 26 and 36 relative to the feature of a facility including a service window and that a further input corresponds to a feature of the user's vehicle.

We will not sustain the rejection of claims 1-37 and 40-43 under 35 U.S.C. § 103 because the examiner has not established a prima facie case of obviousness.

Even if we disregard appellant's argument about neither reference suggesting a facility remote from the machine by finding that the soda machine on the same aisle as the fuel dispensing machine in Phillips is "remote" from the fuel dispensing machine (since being "remote" is relative, the soda machine, being separate from the fuel-dispensing machine, might be considered "remote" therefrom), neither reference discloses the delivery of an amount of cash to the user at the remote facility.

The soda machine in Phillips may accept cash, and may even dispense change to a user, but this is a far cry from a request for an amount of cash by a user via an input to a dispensing machine, communicating that information to a remote facility and

delivering the requested amount of cash after the user arrives at the facility, as set forth in independent claims 1 and 40.

The examiner points to Gatto's recitation of "pay inside" and "cash back" (column 1, line 30 and column 6, lines 25-26) for a suggestion of the amount of cash requested being delivered by a remote facility. The recitation of "pay-at-the-pump" or to pay inside, at column 1, line 30, of Gatto merely describes the conventional fuel dispensing pump wherein the user is requested to make a choice of paying at the pump, e.g., by credit card, or inside, e.g., going to the cashier after dispensing the desired amount of fuel. But we find no suggestion at this portion of Gatto for a user to specifically request an amount of cash by input to a dispensing machine, communicating that information to a remote facility and then delivering the cash at the facility. The user may visit the cashier in a remote facility, but this visit is for paying the amount due for the dispensed fuel and, possibly, for making a further purchase of an item at the remote facility. There is no suggestion within Gatto that the user may request an amount of cash and then have that cash delivered at the remote facility.

Since neither Phillips nor Gatto discloses or suggests this claimed feature of requesting an amount of cash by a user via an

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input to a dispensing machine, communicating that information to a remote facility and delivering the requested amount of cash after the user arrives at the facility, no prima facie case of obviousness is made out.

Accordingly, we will not sustain the rejection of claims 1-37 and 40-43 under 35 U.S.C. § 103 over the applied references.

Since we have not sustained the rejection of claims 38 and 39 under 35 U.S.C. § 102(e) or the rejection of claims 1-37 and 40-43 under 35 U.S.C. § 103, the decision of the examiner is reversed.

REVERSED

Errol A. Krass
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Administrative Patent Judge)
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